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10/560,152	03/27/2007	Hisao Tanaka	450106-05226	9468
7590 William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
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EXAMINER				
DAZENSKI, MARC A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/560,152

**Applicant(s)**

TANAKA ET AL.

**Examiner**

MARC DAZENSKI

**Art Unit**

2621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 2 April 2010 have been fully considered but they are not persuasive.

On page 9 of the remarks, Applicant argues "Nothing in Kikuchi, et al. shows, teaches or suggests each reproduction history information includes type of reproduction method as claimed in claims 12-15," and The examiner respectfully disagrees.

First, the examiner notes that the arguments are substantially identical to those presented on page 8 of the response dated 22 September 2009. In response, the examiner maintains that the response to arguments contained within the non-final rejection dated 4 January 2010 is still applicable.

Second, the examiner notes that a careful reading of the claim shows that the claimed reproduction history information is composed of, in part, "a type of reproduction method." As written, the claim merely requires that there is a type of reproduction method in the reproduction history information. Kikuchi discloses "...when the playback picture is a still picture, the time the still picture lasts and the remaining time of the still picture during the interruption of playback are written. In addition, the elapsed time in reproducing a cell is written as interrupt information" (see e.g. column 11, lines 44-48 and the "still time" and "still remaining time" information of figure 9). Therefore, Kikuchi discloses a still picture playback reproduction mode in addition to the standard PGC or video reproduction mode. Because the system of Kikuchi records interrupt time of two

separate modes, the examiner maintains that the previously cited sections of Kikuchi effectively read on the claim. Absent some special definition of the claimed "type[s] of reproduction method" the examiner must maintain the original rejection.

Regarding new claims 16-19, the examiner maintains that they comprise limitations previously included in independent claim 12 written in dependent form, and are therefore rejected in view of the explanation previously set forth in the prior office action(s).

A full rejection of the pending claims appears below.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

**Claims 14 and 18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. **Claim 18** is drawn to

functional descriptive material recorded on a computer-readable medium. Normally, the claim would be statutory. However, the specification, at page 104 defines the claimed computer readable medium as encompassing statutory media as well as **non-statutory** subject matter such as a "signal" (wherein the disclosure "when the sequence of processes are executed by software, a program that composes the software is installed from a network..." implies that the program is essentially a signal communicated over some sort of transmission medium). The examiner suggests amending the claim so that the program is embodied on a "non-transitory" computer-readable medium in order to claim only statutory embodiments of the program.

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 12-19** are rejected under 35 U.S.C. 102(e) as being anticipated by Kikuchi et al (US Patent 6,532,334), hereinafter referred to as Kikuchi.

Regarding **claim 12**, Kikuchi discloses information reproducing system, information recording/reproducing system, and recording medium applicable to the system. Further, Kikuchi discloses a system which records and reproduces the digital moving-picture information on and from a disk, which reads on the claimed, "an information process apparatus that performs a record and reproduction process for data," as disclosed at column 12, lines 30-35 and exhibited in figure 15; the apparatus comprising:

utilizing playback control information (102) including a management information table `PLY_MAT` (122) as well as a program chain ("PGC") information table `PGCIT`, which are data necessary for playback, the data being recorded on optical disk (10) which has video data and audio data and other information, which reads on the claimed, "reproduction means for performing a reproduction process that reads and reproduces desired material data from a record medium according to the management information file, the material data containing pictures and sound and the management information file managing a file of the material data being recorded on the record medium that is attachable and detachable to and from the information process apparatus," as disclosed at column 4, lines 33-35; column 8, lines 20-39; and exhibited in figures 1, and 3;

MPU of the microcomputer block (30) functioning as if it had a playback end information setting section (30A) by writing playback interrupt information table (124) into the disc, the table (124) including the title number of the title whose playback has been interrupted, the cell ID whose playback has been interrupted, and when the playback picture is a still picture, the time the still picture lasts and the remaining time of

the still picture during the interruption of the playback are written, and further the elapsed time in reproducing a cell is written as interrupt information, which reads on the claimed, "generation means for generating reproduction history information about the reproduction process of the reproduction means, the reproduction history information composed of (a) identification information of reproduced material data, (b) a reproduction end position, and (c) a type of reproduction method," as disclosed at column 11, lines 24-67 (with particular emphasis on lines 24-34 and lines 44-48) and column 15, lines 5-8, as well as exhibited in figures 6 and 9;

the playback interrupt information table (124) having been provided as an independent file at the same level of hierarchy as that of the playback management table (122), which reads on the claimed, "record means for recording a list of the reproduction history information generated by the generation means as one file different from the management information file on the record medium," as disclosed at column 12, lines 1-16 (with particular emphasis on lines 9-12) and exhibited in figure 6;

MPU of the microcomputer block (30) functioning as if it had a playback end information takeout section (30B) for taking out playback end information, which reads on the claimed, "read means for reading the list of the reproduction history information recorded on the record medium by the record means," as disclosed at column 15, lines 5-15;

MPU of the microcomputer block (30) functioning as if it had a playback information resume specifying section (30C) for giving an instruction to resume playback using the playback information, which reads on the claimed, "reproduction

command accepting means for accepting a reproduction command for the material data," as disclosed at column 15, lines 5-15; and,

after the DVD disk (10) has been loaded into the DVD recorder, when the playback is resumed by pressing the resume playback key, the playback interrupt information table is first read from the disk, and on the basis of the playback interrupt information in the playback interrupt information table, the video object is determined, and further the PGC number to be reproduced, cell number and VOB number are determined on the basis of the playback interrupt information in the playback interrupt information table, which reads on the claimed, "reproduction control means for referencing the list of the reproduction history information read by the read means, specifying material data to be reproduced and a reproduction start position according to reproduction history information according to a reproduction method designated by the reproduction command accepted by the reproduction command accepting means, controlling the reproduction means, and starting the reproduction process from the reproduction start position of the specified material data," as disclosed at column 16, lines 46-58 and column 18, lines 30-45.

Regarding **claim 13**, the examiner maintains the claim is the corresponding method to the apparatus of claim 12, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 12 above.

Regarding **claim 14**, the examiner maintains the claim is the corresponding program executing the method of the method of claim 13, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 13 above.



Regarding **claim 15**, the limitations of the claim are rejected in view of the explanation set forth in claim 12 above.

Regarding **claim 16**, the limitations of the claim are rejected in view of the explanation set forth in claim 1 above (wherein the claimed, "wherein types of reproduction methods include at least a tape-like reproduction method that successively reproduces all clips recorded on the recording medium, a clip designation reproduction method that reproduces a designated clip, and an edit list designation reproduction method that reproduces a designated unit of an edit list," has been previously rejected in view of the cited sections of Kikuchi).

Regarding **claims 17-19**, the limitations of the claims are rejected in view of the explanation set forth in claim 16 above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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